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09/551,519	04/18/2000	Itai Kohavi	LILT 17.135	2712

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EXAMINER
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DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/551,519

Applicant(s)

KOHAVI ET AL.

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-16, 29-32 and 37-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 17-26 and 33-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-16, 29-32 and 37-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/2005 3/14/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-11, 17-26, 33-36 have been cancelled, claims 37-52 have been added.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 3/14/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, and the US references have been considered, but the Foreign and NPL references referred to therein has not been considered.

#### ***Response to Amendment / Arguments***

3. A careful reading of the claims indicated allowable necessitated the new rejections below.
4. Applicant's amendment and arguments regarding the 112<sup>th</sup> rejections are convincing, the 112 rejections are withdrawn.

#### ***Claim Objections***

5. Claim 15 is objected to because of the following informalities:  
Examiner cannot find the word "compiled" possibly it should be "compiled."  
Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 12-16, 2—32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

7. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

8. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

9. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

10. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

11. In the present application, though claim 12 claims retaining offerings in computer storage and claims 16 and 29 claim one or more steps performed across networks or communication

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mediums the claims contain only negligible technology and are therefore not in the technological arts.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 37-38, 40-45, 47-52 rejected under 35 U.S.C. 102(e) as being anticipated by Lynch et al (6,018,715).

As per Claim 37.

Lynch et al ('715) discloses:

one or more data storage mediums comprising information of two or more offered travel products from two or more vendors, the information including at least two product types from airline seating, hotel rooms, car rentals, and auxiliary travel support items with any of associated price, time restrictions, use restrictions, class, availability, rules and descriptions, see column 3, line 10 – column 4, line 13;

one or more processors configured with processor control instructions that control accessing information of the one or more data storage mediums and that control dynamically compiling travel packages to select one of the two or more offered travel product types, the control instructions also controlling package compiling based on a matching of defined restrictions and other criteria comprising any of: geographic distributions, type of product, time considerations, cost, intelligent agents and distribution channel limitations, wherein the defined restrictions for at least one product in a package are dependent on another product accepted in or excluded from the package, see column 3, line 10 – column 4, line 13;

the one or more processors further configured with processor control instructions that control package cost determination including any of: summation of individual costs of products included in a compiled package, commissions, discounts and special promotional items, see column 3, lines 53-62 and column 3, line 67 – column 4, line 7;

the one or more processors further configured with processor control instructions that control an interface to enter one or more search requests for possible packages, see figure 2 (34).

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As per claim 38.

Lynch et al ('715) further discloses the compilation is performed partially or wholly before said request for possible packages or interactively during said request, see column 3, line 67 – column 4, line 7.

As per claim 40.

Lynch et al ('715) further discloses remotely accessing two or more travel related items, see column 4, lines 25-63.

As per claim 41.

Lynch et al ('715) further discloses stored information representing two or more of airline seating, hotel rooms, car rental, and auxiliary travel support items, see column 3, line 39 – column 4, line 7.

As per claim 42.

Lynch et al ('715) further discloses the user interface configured to control user searches for possible packages based on a match to desired criteria, see column 4, lines 13-24.

As per claim 43.

Lynch et al ('715) further discloses dynamically reformulating the packages based on availability of said vendor offered products, see column 3, line 67 – column 4, line 24.

As per Claim 44.

Lynch et al ('715) further discloses the steps performed locally or remotely across a LAN/WAN, see column 4, line 44.

As per Claim 45.

Lynch et al ('715) discloses:

data means for storing information comprising two or more offered travel products from two or more vendors, the information including at least two product types from airline seating, hotel rooms, car rentals, and auxiliary travel support items with any of associated price, time restrictions, use restrictions, class, availability, rules and descriptions, see column 3, line 10 – column 4, line 13;

electronic package compiling means for dynamically compiling travel packages by accessing information of the data means to select one of the two or more offered travel product types, the package compiling means also for compiling based on a matching of defined restrictions and other criteria comprising any of: geographic distributions, type of product, time considerations, cost, intelligent agents and distribution channel limitations, wherein the defined restrictions for at least one product in a package are dependent on another product accepted in or excluded from the package, see column 3, line 10 – column 4, line 13;

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electronic package cost determination means for determining package cost including any of: summation of individual costs of products included in a compiled package, commissions, discounts and special promotional items, see column 3, lines 53-62 and column 3, line 67 – column 4, line 7;

electronic interface means for entering one or more search requests for possible packages, see figure 2 (34).

As per claim 47.

Lynch et al ('715) further discloses the compilation is performed partially or wholly before said request for possible packages or interactively during said request, see column 3, line 67 – column 4, line 7.

As per claim 48.

Lynch et al ('715) further discloses remotely accessing two or more travel related items, see column 4, lines 25-63.

As per claim 49.

Lynch et al ('715) further discloses accessing stored information representing two or more of airline seating, hotel rooms, car rentals and auxiliary travel support items, see column 3, line 39 – column 4, line 7.

As per claim 50.

Lynch et al ('715) further discloses electronic interface means is configured to control user searches for possible packages based on a match to desired criteria, see column 4, lines 25-63.

As per claim 51.

Lynch et al ('715) further discloses dynamically reformulating the packages based on availability of said vendor offered products, see column 3, line 67 – column 4, line 24.

As per Claim 52.

Lynch et al ('715) further discloses the steps performed locally or remotely across a LAN/WAN, see column 4, line 44.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 12-16, 29-32, 39, 46 are rejected under 35 U.S.C. 103(A) as being unpatentable over Lynch et al (6,018,715) in view of Tagawa (5,732,398).

As per Claim 12.

Lynch et al ('715) discloses:

retrieving two or more offerings, said offerings including at least two products types selected from airline seating, hotel rooms, car rentals, and auxiliary travel support items with any of associated price, time restrictions, use restrictions, class, availability, rules and descriptions, see column 1, line 21 – column 2, line 15;

retaining said two or more offerings of travel products in computer storage, see column 4, line 66 – column 5, line 7;

intelligently compiling travel packages comprising selecting ones of said two or more offerings of travel products, each package including offerings of at least two product types, said compiling based on a congruency matching of defined restrictions and other criteria comprising any of geographic distributions, type of product, time considerations, cost, intelligent agents, and distribution channel limitations, wherein the defined restrictions for at least one product in a package are dependent on another product accepted in or excluded from the package, see column 4, lines 1-24;

receiving one or more search requests for possible packages, see column 4, lines 14-15;

presenting possible packages meeting a requester's criteria, see column 4, lines 18-24;

determining a total cost by any of: summation of individual costs of products included in said compiled package, commissions, discounts, and special promotional items, see column 3, lines 53-62 and column 3, line 67 – column 4, line 7;

Lynch et al ('715) does not disclose processing payment of a one or more selected travel packages.

Tagawa ('398) teaches processing payment of a one or more selected travel packages, see figure 7c (424) for the benefit of collecting payment for products/services received.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to process payments for one or more packages for the benefit of collecting payment for products/services received.

As per claim 13.

Lynch et al ('715) does not specifically disclose booking reservations.

Tagawa ('398) teaches processing payment of a one or more selected travel packages, see figure 7b (444) for the benefit of completing the recommended travel arrangements.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to book reservations for the benefit of completing the recommended travel arrangements.

As per claim 14.

Lynch et al ('715) further discloses the compilation is performed partially or wholly before said request for possible packages or interactively during said request, see column 3, line 67 – column 4, line 7.

As per Claim 15.

Lynch et al ('715) further discloses dynamically reformulating the packages based on availability of said vendor offered products, see column 3, line 67 – column 4, line 24.

As per Claim 16.

Lynch et al ('715) further discloses the steps performed locally or remotely across a LAN/WAN, see column 4, line 44.

As per Claim 29.

Lynch et al ('715) discloses:

determining available travel products from an inventory, based on any of: historical data, price, class, demand, time before use, type, see column 3, line 67 – column 4, line 24;

placing defined restrictions on two or more of said determined travel products wherein the defined restrictions for at least one travel product are dependent on another travel product when the one product and the other product are offered in a travel package, see column 4, lines 4-7;

offering said two or more of said determined products with associated restrictions to a centralized travel packaging system, said centralized travel packaging system located across one of a computer-based networks, LANs, WANs, and cellular, wireless, Internet, WWW, Satellite-based communication mediums, see column 4, lines 42-63;

Lynch et al ('715) does not specifically disclose receiving confirmed reservations.

Tagawa ('398) teaches confirming the one or more selected travel packages, see figure 7c (522) for the benefit of completing the recommended travel arrangements.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to confirm reservations for the benefit of completing the recommended travel arrangements.

As per Claim 30.

Lynch et al ('715) further discloses restrictions include: which companies may or may not be included in the packages, see column 3, lines 38-46, 40-62, and column 4, lines 1-7.

As per Claim 31.

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Lynch et al ('715) further discloses dynamically reformulating the packages based on availability of said vendor offered products, see column 3, line 67 – column 4, line 24.

As per Claim 32.

Lynch et al ('715) further discloses dynamically reformulating the packages based on availability of said vendor offered products, see column 3, line 67 – column 4, line 24.

As per claim 39.

Lynch et al ('715) does not specifically disclose booking reservations.

Tagawa ('398) teaches processing payment of a one or more selected travel packages, see figure 7b (444) for the benefit of completing the recommended travel arrangements.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to book reservations for the benefit of completing the recommended travel arrangements.

As per claim 46.

Lynch et al ('715) does not specifically disclose an electronic purchase means or booking means.

Tagawa ('398) teaches booking and payment means for one or more selected travel packages, see figure 7b (444) and 7c(420, 424) for the benefit of completing the recommended travel arrangements.

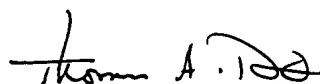
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to book reservations for the benefit of completing the recommended travel arrangements.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3639

May 05